

REMARKS

In the outstanding Office action dated November 4, 2004, claims 17, 18, 20, 24, 25 and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Whitehouse et al. (4,743,265). Additionally, in the outstanding Office action, it appears that the Examiner intended to reject claim 19 (not claim 18) under 35 U.S.C. § 103(a) as being unpatentable over Whitehouse et al. in view of Hakky et al. (6,113,577). Moreover, claims 27 and 28 were rejected under § 103 as being unpatentable over Whitehouse et al. in view of Burgermeister (2004/0193205) and claims 29-33 were rejected under § 103(a) as being unpatentable over Whitehouse et al. in view of Burgermeister as applied to claims 27 and 28 and further in view of Gellman et al. (2002/0055748).

In rejecting the claims under § 102(b) in view of Whitehouse et al., the Examiner stated that platform 12 was removably secured to a catheter handle 14 and 16 and referred the Applicants to FIG. 3 as support for the same. Significantly, independent claim 17 and each of the dependent claims 18-19 and 24-33 recite a catheter comprising a catheter handle and a platform removably secured to the catheter handle. Dependent claim 20 further limits claim 17 by requiring that the removable platform be slideably secured to the catheter handle. It is respectfully submitted, however, that the Whitehouse et al. patent does not teach a platform removably secured to a catheter handle nor an arrangement involving the removable platform being slideably secured to the catheter handle. On the contrary, the Whitehouse et al. reference merely discloses a base member 12 including a housing 36 against which recesses 56A and 56B of handles 14 and 16 are placed. Clearly, such an arrangement does not involve removably securing the handles 14 and 16 to the base 12. That is, placing one item against another does not constitute securing the items together. Moreover, should an individual pick up the handles 14

and 16 of Whitehouse, et al. the base 12 would not remain secured to the handles 14 and 16 as one would expect of items which are secured to each other. Accordingly, it is respectfully submitted that independent claim 17 and dependent claims 18-20 and 24-33 define patentable subject matter.

Turning now to the rejections of the claims under § 103(a), it is respectfully submitted that the combination of the Whitehouse et al. and Hakky et al. references, the combination of the Whitehouse et al. and Burgermeister references and the combination of the Whitehouse et al. Burgermeister and Gellman et al. references were made through improper hindsight. Notably, MPEP 2145 states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine referenced teachings. It is additionally required under MPEP 2143.01 that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" and that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time that the claimed invention was made' because the references relied upon teach all the aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." Further, the MPEP states that "The level of skill in the art cannot be relied upon to provide the suggestion to combine the references." In rejecting the claims under § 103, the Examiner found little or no motivation or suggestion in the references themselves to combine their respective teachings but rather, selected features of one reference and added such features to the teachings of one or more references based upon what the Examiner proffered to be something which would be obvious to one of ordinary skill in the

art. As it is believed to be improper to place such heavy reliance upon what the Examiner believes to be the level skill in the art, it is respectfully submitted that the claims are not obvious in view of the cited art.


Moreover, the combination of Whitehouse et al., Burgermeister and Gellman et al. employed by the Examiner to reject claims 29-33 appears to be particularly tenable. In so rejecting the claims, the Examiner stated that one of ordinary skill in the art would have taken a first step to modify the teachings of the Whitehouse et al. reference to include a knob disclosed in the Burgermeister reference. The Examiner then stated that one of ordinary skill in the art would have taken a second step to modify the combined teachings of the Whitehouse et al. and Burgermeister references to include a cutter disclosed by the Gellman et al. reference. The Examiner then stated that it would have been obvious to one of ordinary skill in the art to require the cutter taken from Gellman et al. and incorporated into the combined teaching of the Whitehouse et al. and Burgermeister references, to be configured so that it could be maneuvered to protrude from a distal tip of a catheter. Further, the Examiner also stated that it would have been of ordinary skill in the art to configure the Gellman et al. cutter to dissect an outer member of a catheter. Again, it is respectfully submitted that such heavy reliance on what one of ordinary skill in the art would presumably do is improper in view of the guidelines provided by the MPEP. Further, even it was proper to so rely on the level of the skill in the art, one of ordinary skill in the art would not take the multiple steps required to meet the limitations recited in claims 29-33. In fact, since the Gellman et al. patent is concerned with cutting tissue, it is not believed that one of ordinary skill in the art would have been inclined to combine the teachings of the Gellman et al. patent with that of Whitehouse et al. and Burgermeister patents. Accordingly, it is believed that claims 29-33 are allowable for these reasons as well.

CONCLUSION

Applicants have attempted to completely respond to the rejections set forth in the outstanding Office action. In view of the above remarks, Applicants respectfully request that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By: 
John V. Hanley
Registration No. 38,171

JVH/kst
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Tele.: (310) 824-5555
Fax: (310) 824-9696
Customer No. 24201
79133.1